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10/670,995	09/23/2003	Safaa H. Hashim	42498-P008US	4520
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EXAMINER				
SEREBOFF, NEAL				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/670,995

**Applicant(s)**

HASHIM, SAFAA H.

**Examiner**

NEAL R. SEREBOFF

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 3/17/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4-31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. In the Amendment dated 3/17/2008, the following has occurred: Claims 1 – 3 have been canceled; Claims 4 – 31 have been added. Claims 4 - 31 are pending.

### ***Claim Objections***

#### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7 – 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 7 – 16 provides for the use of scalability, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 7 - 16 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

4. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "incrementally" in claim 10 is a relative term which renders the claim

indefinite. The term "incrementally" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The Examiner is unsure how often the modules are purchased and therefore understands the purchasing to occur as needed.

5. Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "similar" in claim 13 is a relative term which renders the claim indefinite. The term "similar" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The Examiner is unsure if similar means 99% the same, 90% the same, or 20% the same.

6. Claim 18 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is not clear from the claims who are the first and second parties to differentiate from the claimed "third party." The Examiner understands the claim to mean that the customers do not need to purchase the software but can use a Web centric or application service provider (ASP) model. Claim 19 is rejected for the same reasons as it depends upon claim 18.

7. Claims 21, 22, 24 - 28, 30 and 31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are understood to be the intended use of the described structure without the introduction of additional elements. As the intended use of an

element has no patentable weight, these claims may or may not be performed. Additionally, the lack of structure brings up the confusion as to the correct statutory class.

8. Claims 30 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim uses the term “remember,” to describe a computer based activity. The Examiner notes that remember refers to the mind of a person, or re-mind-er. The Examiner understands that this claim means that the database stores information.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. The 35 U.S.C. 101 statute is included here in support of the 35 U.S.C. 112, 2nd paragraph rejections of claims 7 – 19 and 21, 22, 24 - 28, 30 and 31 above.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 4 – 31 are rejected under 35 U.S.C. 102(b) based upon a public use or sale of the invention, ZeBU Corporation software, herein referred to as ZeBU.

13. An issue of public use or on sale activity has been raised in this application. In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b),

additional information regarding this issue is required as follows: How the ZeBU product, converted later to IIT, is different than the claimed invention.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

14. As per claim 4, ZeBU teaches a method for facilitating communication among at least one participant in an insurance-underwriting process, the method comprising:

- Providing a web-based system for storing and organizing a plurality of data related to the insurance-underwriting process (The ZeBU HUB solution),
  - The web-based system adapted to allow collaboration among the at least one participant via the Internet (ZeBU Solutions – AIMSuite Overview or AIM QuickApp where applications are sent to other users),
  - The web-based system comprising a first module for creating a case (AIM DMS) and a second module for tracking the case among the at least one participant after the case has been submitted to a carrier for consideration (AIM QuickView);
- Sharing, via the web-based system, the plurality of data among the at least one participant (ZeBU Solutions – AIMSuite Overview);
- Wherein the web-based system comprises a multi-layer, modular architecture (ZeBU Solutions – AIMSuite Overview); and
- Wherein the at least one participant comprises at least one user (ZeBU Solutions – AIMSuite Overview), and the web-based system is adapted to restrict the plurality of data accessible to the at least one user based on a plurality of attributes of the at least one user (System Administration).

15. As per claim 5, ZeBU teaches the method of claim 4 as described above. ZeBU further teaches the method wherein the at least one participant is selected from the group consisting of:

- Insurance carriers,
- Insurance agencies,
- Insurance agents (The ZeBU HUB solution), and
- Service providers.

16. As per claim 6, ZeBU teaches the method of claim 4 as described above. ZeBU further teaches the method wherein the at least one user is selected from the group consisting of: agents and case managers (The ZeBU HUB solution).

17. As per claim 7, ZeBU teaches the method of claim 4 as described above. ZeBU further teaches the method wherein the multi-layer, modular architecture comprises:

A plurality of applications, each application of the plurality of applications comprising a plurality of modules, each module of the plurality of modules comprising a plurality of tools, each tool of the plurality of tools comprising a plurality of views (ZeBU Solutions, AIM QuickView, AIM GA, AIM DMS, AIM ITS and AIM HO).

18. As per claim 8, ZeBU teaches the method of claim 7 as described above. ZeBU further teaches the method wherein the plurality of applications are adapted to employ a desktop visual metaphor for accessing the plurality of modules (WEB QuickView).

19. As per claim 9, ZeBU teaches the method of claim 7 as described above. ZeBU further teaches the method wherein the plurality of modules are adapted to allow the plurality of applications to be scalable (The Examiner notes that no positive method step occurs and

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therefore has no patentable weight. Rather, the claim creates the option of something being performed. It is equally likely that nothing is ever performed).

20. As per claim 10, ZeBU teaches the method of claim 9 as described above. ZeBU, as understood, further teaches the method wherein the plurality of modules are purchased incrementally (Select Tech Posts Record 171% Growth in AIM QuickView. In addition, the ZeBU system had the incremental purchase functionality built within the software as evidenced by ZeBULLETIN, April 2001, "ZeBU GA Power-User Saves Time and Money").

21. As per claim 11, ZeBU teaches the method of claim 7 as described above. ZeBU further teaches the method wherein the plurality of modules comprises:

- A user profile module (Contact Management System or ZeBU AIM GA);
- A general administration module (System Administration); and
- A business module (ZeBU AIM QuickView).

22. As per claim 12, ZeBU teaches the method of claim 7 as described above. ZeBU further teaches the method wherein the plurality of tools comprises at least one generic tool (AIM GA, reporting functions) and at least one entity-specific tool (Contact Management System).

23. As per claim 13, ZeBU teaches the method of claim 12 as described above. ZeBU further teaches the method wherein the at least one generic tool is adapted to exist in more than one module with similar functionality (ZeBU QuickView as evidenced by the ZeBulletin, November 2000, "ZeBU Delivers Web QuickView as Promised").

24. As per claim 14, ZeBU teaches the method of claim 7 as described above. ZeBU further teaches the method wherein the plurality of views comprises (The Examiner notes that all views represent non-functional descriptive information and therefore have no patentable weight):



A summary view;

A list view; and

A detail view (AIM QuickView).

25. As per claim 15, ZeBU teaches the method of claim 7 as described above. ZeBU further teaches the method wherein the multi-layer, modular architecture is adapted to allow development of new applications, modules, tools, or views (News & Events where future news is anticipated).

26. As per claim 16, ZeBU teaches the method of claim 4 as described above. ZeBU further teaches the method wherein the plurality of attributes of the at least one user comprises (The Examiner notes that the plurality of attributes represents the Intended Use of the method and therefore has no patentable weight):

- The at least one user's role in the insurance underwriting process (AIM Home Office);
- The at least one user's identity (AIM GA); and
- A context in which the at least one user seeks access to the plurality of data (AIM GA).

27. As per claim 17, ZeBU teaches the method of claim 4 as described above. ZeBU further teaches the method wherein the step of sharing the plurality of data further comprises encrypting the plurality of data using a secure encryption technology (Financial Institution Specific Information).

28. As per claim 18, ZeBU teaches the method of claim 4 as described above. ZeBU further teaches the method, as understood, wherein the web-based system is deployed on a portal hosted by a third party (WEB QuickView).

29. As per claim 19, ZeBU teaches the method of claim 4 as described above. ZeBU further teaches the method wherein the web-based system is deployed on a framework for a plurality of applications (AIM Direct Marketing System, deployable on Microsoft Windows).

30. As per claim 20, ZeBU teaches a system for facilitating communication among participants in an insurance-underwriting process, the system comprising:

- At least one database adapted to store a plurality of data related to the insurance-underwriting process (ZeBU software, as evidenced by ZeBULLETIN, April 2001, “ZeBU Introduces ZeBU NET);
- At least one server coupled to the at least one database, the at least one server adapted to host a web-based system for allowing collaboration among the participants via the Internet (ZeBU software, as evidenced by ZeBULLETIN, April 2001, “ZeBU Introduces ZeBU NET);
- At least one client coupled to the at least one server, the at least one client adapted to allow access to the web-based system (ZeBU software, as evidenced by ZeBULLETIN, April 2001, “ZeBU Introduces ZeBU NET);
- Wherein the web-based system comprises a multi-layer, modular architecture (ZeBU Solutions – AIMSuite Overview); and
- Wherein the participants comprise at least one user, and the web-based system is adapted to restrict the plurality of data accessible to the at least one user based on a plurality of attributes of the at least one user (ZeBU Software, Secure Internet access to application status, policy data, agent and company data).

31. As per claim 21, ZeBU teaches the system of claim 20 as described above. ZeBU further teaches the system wherein the plurality of data comprises data related to an insurance client (The ZeBU HUB solution. The Examiner notes that the particular data is considered non-functional descriptive information and therefore has no patentable weight).

32. As per claim 22, ZeBU teaches the system of claim 20 as described above. ZeBU further teaches the system wherein the plurality of data comprises data related to an insurance case or policy (The ZeBU HUB solution. The Examiner notes that the particular data is considered non-functional descriptive information and therefore has no patentable weight).

33. As per claim 23, ZeBU teaches the system of claim 20 as described above. ZeBU further teaches the system further comprising:

- A data-translation engine (ZeBU software, as evidenced by ZeBULLETIN, April 2001, ZeBU QUIC);
- A workflow engine (System Administration);
- A web-application-transactional engine (ZeBU Solutions –AIMSuite Overview, HUB);  
and
- A business-rules engine (AIM Home Office- makes underwriting decisions).

34. As per claim 24, ZeBU teaches the system of claim 23 as described above. ZeBU further teaches the system wherein the web-application-transactional engine is adapted to send the plurality of data to, and receive the plurality of data from, at least one application associated with the web-based system (ZeBU Solutions –AIMSuite Overview, HUB. The Examiner Notes that the statements following adapted to are considered the intended use and therefore have no patentable weight).

35. As per claim 25 ZeBU teaches the system of claim 23 as described above. ZeBU further teaches the system wherein the data-translation engine is adapted to translate and format the plurality of data as the plurality of data is shared among the participants (ZeBU Solutions – AIMSuite Overview, QuickView. The Examiner Notes that the statements following adapted to are considered the intended use and therefore have no patentable weight).

36. As per claim 26 ZeBU teaches the system of claim 25 as described above. ZeBU further teaches the system wherein the data-translation engine ensures that a receiving party can receive the plurality of data in a preferred format without manual transcribing (ZeBU Solutions – AIMSuite OverView, QuickView as evidenced by the ZeBulletin, November 2000, “AIM QV/ GA Integration is Here!” The Examiner Notes that the statements following ensures are considered the intended use and therefore have no patentable weight).

37. As per claim 27 ZeBU teaches the system of claim 23 as described above. ZeBU further teaches the system wherein the workflow engine implements a plurality of workflows comprising a plurality of tasks and subtasks executed in a predefined sequence (ZeBU Hub. The Examiner Notes that the statements following implements are considered the intended use and therefore have no patentable weight.)

38. As per claim 28 ZeBU teaches the system of claim 23 as described above. ZeBU further teaches the system wherein the plurality of workflows comprises at least one public workflow and at least one private workflow (ZeBU HUB).

39. As per claim 29, ZeBU teaches the system of claim 20 as described above. ZeBU further teaches the system further comprising a view-state database, the view-state database adapted to track a current state of the plurality of views (AIM or WEB QuickView).

40. As per claim 30, ZeBU teaches the system of claim 29 as described above. ZeBU, as understood, further teaches the system wherein the view-state database is adapted to remember the current state of the plurality of views upon log-off of the at least one user (AIM GA. The Examiner Notes that the statements following adapted to are considered the intended use and therefore have no patentable weight.).

41. As per claim 31, ZeBU teaches the system of claim 30 as described above. ZeBU further teaches the system wherein the view state database is further adapted to restore the current state of the plurality of views upon log-in of the at least one user (AIM QuickView. The Examiner notes that the display of data on a screen is similar to the creation of a report and therefore the information displayed is considered non-functional. The Examiner Notes that the statements following adapted to are considered the intended use and therefore have no patentable weight.).

#### ***Response to Arguments***

42. Applicant's arguments with respect to claims 4 - 31 have been considered but are moot in view of the new ground(s) of rejection.

#### ***Conclusion***

43. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Freedman et al., U.S. Pre-Grant Publication 2002/ 0002475

Maury et al., U.S. Pre-Grant Publication 2002/ 0046064

Grover et al., U.S. Pre-Grant Publication 2002/ 0188484

44. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NEAL R. SEREBOFF whose telephone number is (571)270-1373. The examiner can normally be reached on Mon thru Thur from 7:30am to 5pm, with 1st Fri off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on (571) 272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/N. R. S./

Examiner, Art Unit 3626

6/2/2008

/Robert Morgan/

Primary Examiner, Art Unit 3626